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Winfried K. W. Holscher

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SUITE 1201

NEW HAVEN, CT 06510

EXAMINER

MACARTHUR, VICTOR L

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Please find below and/or attached an Office communication concerning this application or proceeding.

The time period for reply, if any, is set in the attached communication.

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DETAILED ACTION

Claims 48-73 remain withdrawn from further consideration pursuant to 37 CFR 1.142(b) as being drawn to a nonelected species, there being no allowable generic or linking claim. Election was made **without** traverse in the reply filed on 5/5/2008.

Claim Objections

Claims 38-47 are objected to because of the following informalities:

- Each element or step of the claims has not been separated by a line indentation.

See 37 CFR 1.75 and MPEP § 608.01(i)-(p).

Appropriate correction is required. For purposes of examining the instant invention, the examiner has assumed these corrections have been made.

Claim Rejections - 35 USC § 112

The following is a quotation of the second paragraph of 35 U.S.C. 112:

The specification shall conclude with one or more claims particularly pointing out and distinctly claiming the subject matter which the applicant regards as his invention.

Claims 38-47 are rejected under 35 U.S.C. 112, second paragraph, as being indefinite for failing to particularly point out and distinctly claim the subject matter which applicant regards as the invention.

The claims are generally narrative and indefinite, failing to conform to current U.S. practice as follows:

- It is unclear if claimed “connecting device” (line 1 of claim 1) invention is meant to be structurally limited by the elements of the preamble (e.g., a first extruded hollow

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profile work piece (10), a second work piece, etc.) or if those elements are merely intended for use therewith. Note that these elements are set forth as being mere functional intended use in the preamble but are referred to positively elsewhere throughout the body of the claims (e.g., claims 38, 39, 46, 47). It is unclear how the invention can be both intended for use with elements (i.e., by being separate therefrom) and also structurally comprise those elements (i.e., not being separate therefrom) at the same time. For purposes of examination the claims are taken without combination.

- The word "means" (line 7 of claim 38) is preceded by the word(s) "connecting" in an attempt to use a "means" clause to recite a claim element as a means for performing a specified function. However, since no function is specified by the word(s) preceding "means," it is impossible to determine the equivalents of the element, as required by 35 U.S.C. 112, sixth paragraph. See *Ex parte Klumb*, 159 USPQ 694 (Bd. App. 1967). Applicant is required to:
 - Amend the claims in accordance with MPEP 2181(I) to properly invoke 112 6th paragraph so that the phrase "means for" or "step for" is modified by functional language without being modified by sufficient structure, material, or acts for performing the claimed function; or
 - Delete the "means" language from the claims
- The claims are replete with confusing double inclusions which render the scope unclear. For instance, it is unclear if "a second hollow profile (10)" (last line of claim 38) is meant to refer to the previously recited "a first hollow profile work piece (10)"

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(lines 2-3 of claim 38), "a second work piece" (lines 5-6 of claim 38) or to some additional element. It is also unclear if "an undercut space" (last two lines of claim 38) is meant to refer to the previously recited undercut space or an additional undercut space. Note that while drawing reference characters may be used in the claims, no single number (e.g., 10) may be used to designate more than one claimed element.

For the reasons mentioned above a great deal of confusion and uncertainty exists as to the proper interpretation of the claim limitations. In accordance with the MPEP § 2173.06, rejection under 35 U.S.C. 102 or 35 U.S.C. 103 follows based on the examiner's best understanding of the claim scope. The applicant is strongly urged to amend **the entirety of the claims including non-elected claims (not only the examples listed above)** to conform to current U.S. practice.

Claim Rejections - 35 USC § 102/103

The following is a quotation of the appropriate paragraphs of 35 U.S.C. 102 that form the basis for the rejections under this section made in this Office action:

A person shall be entitled to a patent unless –

(b) the invention was patented or described in a printed publication in this or a foreign country or in public use or on sale in this country, more than one year prior to the date of application for patent in the United States.

The following is a quotation of 35 U.S.C. 103(a) which forms the basis for all obviousness rejections set forth in this Office action:

(a) A patent may not be obtained though the invention is not identically disclosed or described as set forth in section 102 of this title, if the differences between the subject matter sought to be patented and the prior art are such that the subject matter as a whole would have been obvious at the time the invention was made to a person having ordinary skill in the art to which said subject matter pertains. Patentability shall not be negated by the manner in which the invention was made.

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Claims 38-47 are rejected under 35 U.S.C. 102(b) as anticipated by or, in the alternative, under 35 U.S.C. 103(a) as obvious over Hoscher (U.S. Patent 6,582,149).

Holscher appears to disclose all of the applicant's claim limitations as best understood by the examiner (see 35 U.S.C. § 112 2nd paragraph rejections above).

The prior art discloses applicant's claimed connecting device structure.

The prior art structure is presumed to be fully capable of performing applicant's functional limitations in accordance with MPEP 2112.01(I).

Response to Arguments

Applicant's arguments with regard to the claim rejections have been fully considered but they are not persuasive.

Applicant argues that the prior art does not disclose applicant's limitation "wherein the connecting means in a first position lies inside side contours of the socket profile and in a second connecting position projects beyond said socket profile at least on one side and has an outer contour which engages in a retaining manner in an undercut space provided on a second hollow profile". This is not persuasive:

- As detailed above the claims are replete with 112 2nd errors that make the scope of the claims impossible to determine. As a matter of necessity, the examiner must assume the broadest interpretation that the claimed "connecting device" comprises only the socket profile structure as shown in figures 3-6. Accordingly the first profile, second profile, screws and any description thereof constitute elements that are merely intended for use with the claimed "connecting device". That is to say

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that applicant's connecting device is not structurally limited by the profiles and screws but merely being claimed as capable of use therewith. Accordingly any prior art connecting device that is capable of use with a profile and screws will read on the claims as best understood by the examiner.

- The prior art “connecting device” structure is presumed to be fully capable of performing applicant's functional limitations in accordance with MPEP 2112.01(I) and more specifically the case law cited therein. If the applicant wishes to demonstrate that the prior art is incapable of performing the claimed functions the burden of obtaining and testing the prior art lies solely with the applicant since the Patent Office is in no position to obtain and/or test prior art products.
- If applicant actually wishes to structurally limit the product invention by the profiles and screws, then the claims must be amended accordingly. For instance the applicant might claim --A connection assembly comprising: a connecting device, a first extruded hollow profile work piece, a second hollow profile work piece...-- or similar language that clearly sets forth that the profiles are meant to structurally limit the claims.

Conclusion

Applicant's amendment necessitated the new ground(s) of rejection presented in this Office action. Accordingly, **THIS ACTION IS MADE FINAL**. See MPEP § 706.07(a). Applicant is reminded of the extension of time policy as set forth in 37 CFR 1.136(a).

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A shortened statutory period for reply to this final action is set to expire THREE MONTHS from the mailing date of this action. In the event a first reply is filed within TWO MONTHS of the mailing date of this final action and the advisory action is not mailed until after the end of the THREE-MONTH shortened statutory period, then the shortened statutory period will expire on the date the advisory action is mailed, and any extension fee pursuant to 37 CFR 1.136(a) will be calculated from the mailing date of the advisory action. In no event, however, will the statutory period for reply expire later than SIX MONTHS from the date of this final action.

Any inquiry concerning this communication or earlier communications from the examiner should be directed to Victor MacArthur whose telephone number is (571) 272-7085. The examiner can normally be reached on 8:30am - 5:00pm.

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Daniel P. Stodola can be reached on (571) 272-7087. The fax phone number for the organization where this application or proceeding is assigned is (571) 273-8300.

Information regarding the status of an application may be obtained from the Patent Application Information Retrieval (PAIR) system. Status information for published applications may be obtained from either Private PAIR or Public PAIR. Status information for unpublished applications is available through Private PAIR only. For more information about the PAIR system, see <http://pair-direct.uspto.gov>. Should you have questions on access to the Private PAIR system, contact the Electronic Business Center (EBC) at 866-217-9197.

March 9, 2009

/Victor MacArthur/
Primary Examiner, Art Unit 3679